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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,506	05/18/2005	Juergen Hofmann	30882/DP024	4301
4743 7590 09/29/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER BON, MING Y	
			ART UNIT 2625	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/535,506

**Applicant(s)**

HOFMANN, JUERGEN

**Examiner**

MING HON

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 15 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6, 8, and 13-14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gassho, USPN 7136486.

3. As per Claim 1, Gassho teaches a system for the automatic generation of printable files from data in a database, said system comprising a printing system comprising at least one print processing component having at least one of a printer and a printable file processor, wherein

- the printing system has comprises at least one print job generation element (Gassho, Figure 1, Component 44; the content server contains a print job generator)
- the print job generation element can be connected to a server via a first interface (Gassho, Figure 1, Component 42 and Component 44, the proxy server is connected to the content server which contains a print job generator)
- the server can be connected to a database via a second interface, (Gassho Figure 1, Component 42, 44, and 46; Content database is interfaced to the proxy server through the content server)
- the print job generation element is capable of requesting and receiving data from the database, (Gassho, Column 6, Lines 1-7, Figure 1, Component 45a and 46, display connection that would be necessary for communication between user and content database) and
- the print job generation element is capable of preparing the data from the database as a function

of the requirements of the print processing component is further capable of generating printable files. (Gassho, Figure 1, Component 45c and Column 25, Lines 65-67 and Column 26, Lines 1-3)

4. As per Claim 2, Gassho teaches the system according to Claim 1 wherein the database is located outside of the area of the printing system. (Gassho, Figure 1, Component 46; database is located remote from the printer)

5. As per claim 3, Gassho teaches the system according to Claim 1, wherein the print job generation element is a program on at least one computer of the printing system. (Gassho, Column 25, Lines 15-25)

6. As per claim 6, Gassho teaches the system according to Claim 1, wherein the print job generation element can be connected to the server temporarily and/or permanently via the Internet. (Gassho, Column 4, Lines 23-30)

7. As per Claim 8, Gassho teaches a method for the automatic generation of printable files from data in a database, by means of which the files are generated, printed out and/or further processed by a printing system of comprising at least one print processing component and one print job generation element(Gassho, Figure 1) comprising the following steps:

- the print job generation element generating a first message that contains a call to a server for a specific method with parameters, (Gassho, Figure 13, Step (2) and Figure 14, Component S72, print job generation element requesting information from printer via a server. Server is used to communicate with printer)
- the print job generation element establishing a connection to the server via a first interface (Gassho, Figure 1, Component 42 and Component 44, the proxy server is connected to the content server which contains a print job generator)
- the print job generation element transmitting the first message to the server via the first interface (Gassho, Figure 14, Component S72, print job generation element requesting information from printer via a server. Server is used to communicate with printer)

- the server processing the first message by calling the specific method with appertaining parameters, (Gassho, Figure 13, Step (4))
- the server a connection to the database via a second interface, (Gassho Figure 1, Component 42, 44, and 46; Content database is interfaced to the proxy server through the content server)
- the server retrieving data from the database via the second interface, (Gassho, Figure 7, Step (7), the print job data consists of content that is retrieved from the content database. The connection from the server to the content server to the content database is considered second interface)
- the server sending the result of the call for the specific method in the form of a second message back to the print job generation element (Gassho, Figure 13, Step (10)) and
- the print job generation element generating at least one printable file from the result of the call for the specific method. (Gassho, Figure 14, Component S77)

8. As per Claim 13, Gassho teaches the method according to Claim 8 comprising the print job generation element checking at the start whether any updates are available on the server and updating its configuration automatically if an update is available. (Gassho, Figure 13, Step (1)), print job generation element checking at the start whether any updates are available on the server is equivalent of the user submitting a request to access the print generation element or content database because it will update the request.)

9. As per Claim 14, Gassho teaches the method according to Claim 13, comprising transmitting a new processing file during the updating procedure. (Gassho, Figure 13, Step (1)), print job generation element checking at the start whether any updates are available on the server is equivalent of the user submitting a request to access the print generation element or content database because it will update the request. The request is sent in a message or a file)

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gassho USPN 7136486 as applied to Claim 1 and 8 respectively and further in view of Che-Mponda et al. US2003/0069801 hereinafter referred to as Che-Mponda.

12. As per Claim 4, Gassho teaches the system according to Claim 1, Gassho does not teach wherein the first interface is a SOAP (Simple Object Access Protocol) interface, while the server is a SOAP server; However Che-Mponda teaches it. (Che-Mponda, Paragraph [0056])

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Che-Mponda into Gassho. Gassho teaches a first interface between the server and the print generation unit but was silent on how the two units are interfaced. SOAP was a popular protocol used at the time of the invention was made and allowed effective communication between two units as in peer to peer connection. There would have been beneficial to use a SOAP protocol in the first interface.

Therefore it would have been obvious to one of ordinary skill to combine the two references to obtain the invention in Claim 4.

13. As per Claim 5, Gassho in view of Che-Mponda teaches the system according to Claim 4, wherein the SOAP interface uses HTTP/HTTPS as a data transmission protocol. (Che-Mponda, Paragraph [0056])

Analysis is analogous to that made in Claim 4.

14. As per Claim 9, Gassho teaches the method according to Claim 8. Gassho does not teach comprising communicating between the print job generation element and the server takes place via a SOAP (Simple Object Access Protocol) interface; However Che-Mponda teaches it. (Che-Mponda, Paragraph [0056])

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Che-Mponda into Gassho. Gassho teaches a first interface between the server and the print generation unit but was silent on how the two units are interfaced. SOAP was a popular protocol used at the time of the invention was made and allowed effective communication between two units as in peer to peer connection. There would have been beneficial to use a SOAP protocol in the first interface.

Therefore it would have been obvious to one of ordinary skill to combine the two references to obtain the invention in Claim 9.

15. As per Claim 10, Gassho in view of Che-Mponda teaches the method according to Claim 9, comprising communicating via an Apache SOAP API (Application Programming Interface). (Che-Mponda, Paragraph [0056])

Analysis is analogous to that made in Claim 9.

16. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gassho as applied to Claim 1 and 8 and further in view of Gluckman US2002/0161744.

17. As per Claim 7, Gassho teaches the system according to Claim 1. Gassho does not teach wherein the second interface is a PL/SQL (Procedural Language/Structured Query Language) layer; However Gluckman teaches it. (Gluckman, Paragraph [0017])

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Gluckman into Gassho. Gassho teaches a second interface between a server and database but was silent on how the two units are interfaced. PL/SQL was a popular layer used at the time of the invention was made and allowed effective communication between an accessing unit and database. There would have been clearly beneficial to use a PL/SQL interface.

Therefore it would have been obvious to one of ordinary skill to combine the two references to obtain the invention in Claim 7.

18. As per Claim 11, Gassho teaches the method according to Claim 8. Gassho does not teach comprising communicating between the server and the database takes place via a PL/SQL (Procedural Language/Structured Query Language) layer; However Gluckman teaches it. (Gluckman, Paragraph [0017])

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Gluckman into Gassho. Gassho teaches a second interface between a server and database but was silent on how the two units are interfaced. PL/SQL was a popular layer used at the time of the invention was made and allowed effective communication between an accessing unit and database. There would have been clearly beneficial to use a PL/SQL interface.

Therefore it would have been obvious to one of ordinary skill to combine the two references to obtain the invention in Claim 11.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gassho USPN 7136486 as applied to Claim 8 and further in view of Che-Mponda et al. US2003/0069801 hereinafter referred to as Che-Mponda and McLaughlin, Brett, Java & XML 2<sup>nd</sup> Edition: Chapter 12: SOAP, August 8, 2001, <http://oreilly.com/catalog/javaxml2/chapter/ch12.htm> hereinafter referred to as McLaughlin.



20. As per Claim 12, Gassho teaches the method according to Claim 8, comprising the steps of:

- the print job generation element (Gassho, Figure 1, Component 44)
- the print job generation element (Gassho, Figure 1, Component 44)

to the print job generation element. (Gassho, Figure 1, Component 44)

Gassho does not teach:

- generating a first message by calling an instance of a call class of an Apache SOAP (Simple Object Access Protocol) API (Application Programming Interface) and sets setting properties of this object,
- transmitting the first message to the server,
- on the part of the server, a web server accepting the first message with the call and evaluating the first message,
- calling the desired method with the transmitted parameters,
- converting the return value into a second SOAP message and returning the message as a response via HTTP, and
- the instance of the call class on the client side analyzing the second message and returning the obtained result

Che-Mponda teaches

- generating a first message by calling an instance of a call class of an Apache SOAP (Simple Object Access Protocol) API (Application Programming Interface) and sets setting properties of this object, (Che-Mponda, Figure 4, "Client API software" by using a SOAP envelope, the calling of an instance of a call class was made.)

- transmitting the first message to the server, (Che-Mponda, Figure 4, "Transmission via protocol")
- on the part of the server, a web server accepting the first message with the call and evaluating the first message, (Che-Mponda, Figure 4, "Web Server")
- calling the desired method with the transmitted parameters; (Che-Mponda, Figure 4, "Servlets", interprets the desired method which is in xml file and responds back appropriately)
- converting the return value into a second SOAP message and returning the message as a response via HTTP, (Che-Mponda, Figure 4, "Transmission via Web Protocol" and "Web server Software") and
- the instance of the call class on the client side analyzing the second message and returning the obtained result (Che-Mponda, Figure 4, "Client API Software")

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Che-Mponda into Gassho. Gassho teaches various communicating between each other as seen in Gassho, Figure 1 however Gassho was silent on the type of protocol used to communicate between the elements. SOAP was a popular protocol used at the time of the invention was made and allowed effective communication between two units as in peer to peer connection.

Gassho does not teach

- associating the sent URL with the Apache SOAP API's RPC router-servlet where the server-SOAP object is known.
- transmitting the call to this servlet,
- the RPC router-servlet analyzing the first SOAP message, determines determining the class to be called and initiating the call,

McLaughlin teaches

- associating the sent URL with the Apache SOAP API's RPC router-servlet where the server-SOAP object is known. (McLaughlin, Paragraph with header, "RPC or Messaging", the information is sent via HTTP since it uses a SOAP protocol and therefore a URL is necessary to identify the destination)
- transmitting the call to this servlet, (McLaughlin, Paragraph with header, "RPC or Messaging"
- the RPC router-servlet analyzing the first SOAP message, determines determining the class to be called and initiating the call, (McLaughlin, Paragraph with header, "RPC or Messaging", analyzes the message for errors)

Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of McLaughlin into Gassho. Gassho teaches various communicating between each other as seen in Gassho, Figure 1 however Gassho was silent on the type of protocol used to communicate between the elements. SOAP was a popular protocol used at the time of the invention was made and allowed effective communication between two units as in peer to peer connection. However SOAP's protocol has it's faults and there are various options to overcome them. RPC router- servlet allows better error handling and passing of complex types across the network thus improving on the SOAP protocol.

Therefore it would have been obvious to one of ordinary skill to combine the three references to obtain the invention in Claim 12.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MING HON whose telephone number is (571)270-5245. The examiner can normally be reached on Mon- Fri 7:30 to 5:00 EST; 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571)272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H./  
Examiner, Art Unit 2625

/Mark K Zimmerman/  
Supervisory Patent Examiner, Art Unit 2625